REMARKS

This Amendment is being filed in response to the Office Action mailed on April 17, 2008, which has been reviewed and carefully considered. Reconsideration and allowance of the present application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-20 are pending in the Application.

Applicants thank the Examiner for acknowledging the claim for priority and receipt of certified copies of all the priority documents.

By means of the present amendment, the current Abstract has been deleted and substituted with the enclosed New Abstract which better conforms to U.S. practice.

By means of the present amendment, claims 1-20 are amended for non-statutory reasons, such as for better form including beginning the dependent claims with 'The' instead of 'A'. Such amendments are not made in order to address issues of patentability and Applicants respectfully reserve all rights under the Doctrine of Equivalents.

In the Office Action, claim 1 is objected to for certain informalities. In response, claim 1 is amended in accordance with the Examiner's suggestions. Accordingly, withdrawal of the objection to claim 1 is respectfully requested.

In the Office Action, the specification is objected to as allegedly failing to provide antecedent basis for the subject matter of claim 20 which recites a "computer program product". In addition, claim 20 is rejected under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. Without agreeing with the Examiner, and merely in an effort to advance prosecution and move this case towards consideration and allowance, the amendment to claim 20 has rendered both the specification objection and claim rejection under 35 U.S.C. §101 moot. Accordingly, withdrawal of the objection and rejection is respectfully requested.

In the Office Action, claims 1 and 19 and dependent claims 2-17 are rejected under 35 U.S.C. 112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter which application regards as the invention. As the basis for this rejection, the Office Action contends that claims 1 and 19

and dependent claims 2-17 are replete with intended use recitations due to claim terms such as "operable to", etc. Applicants respectfully disagree.

It is axiomatic that a functional limitation should be accorded patentable weight. (See, e.g., *Ex parte* Sherman, 45, USPQ 532, 534 (Pat. Off. Bd. App. 1939):

> While the claims contain numerous functional statements, these statements seem to be used for the purpose of clearly defining or differentiating elements which have been positively included in the claims. We see no objection to the use to the functional statement to define an element, even where the element may be set forth by the term "means."

The claim limitations associated with "operable to" are not merely recitations of intended use as erroneously contended in the Office Action, rather such limitations impart functional characteristics of the claimed features that serve to clearly and distinctly define the scope of the claimed subject matter. Accordingly, withdrawal of the rejection under 35 U.S.C. §112 is respectfully requested.

In the Office Action, claims 1-8 and 10-20 are rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent

Publication No. 2005/0041150 to Gewickey ("Gewickey"). In addition, claim 9 is rejected under 35 U.S.C. §102(e) as allegedly unpatentable over U.S. Patent No. 7,200,323 to Evans ("Evans"). It is respectfully submitted that claims 1-20, are allowable over Gewickey either singularly or in combination with Evans, for at least the following reasons.

Gewickey generally discloses a method to control access to additional or enhanced content for original media content. In particular, Gewickey teaches (in paragraphs [0133] - [0140] and in particular, FIG. 9) a process for determining if enhanced content is authorized to be associated with media content. Gewickey specifically discloses in paragraph [0140] the method of Gewickey for accessing enhanced content as follows:

> In step 522, the media content is loaded into the content view. In step 524, a user submits a request to access Internet content. In step 526, a media content identifier is received, extracted and/or calculated. In step 530 a list of authorized URLs is accessed. Again, this list can be stored with the media content or can be remotely accessed. In step 532, it is determined if the Internet content URL attempting to be accessed is included within the authorized list. If the Internet content URL is on the list, step 334 is entered where the user is allowed access to the authorized Internet content. If, in step 332, it is determined that the Internet content URL is

> not on the authorized list, the requested Internet content is not displayed, and an error or other notification is issued (e.g., an error message is displayed in a pop-up window).

In other words, Gewickey shows a content control process whereby in response to a user selection of a URL presented to the user in a media content view, the content control process determines if the Internet content of the selected URL is included within a list of authorized URLs (or alternatively, a list of unauthorized URLs) associated with the media content. The URL list is not presented to the user, rather the URL list is simply accessed and the listed URLs are compared to the selected URL to determine if access to the URL content of the user selected URL is authorized or not authorized.

Gewickey further discloses (in paragraph [0050]) a bookmark manager 186 that generates bookmarks by marking locations in video playback with bookmarks (video bookmarks) that can be selected by a user to launch a web session and go to a preset web book marked source to retrieve video-related information, whereby the bookmark allows the user to then later return to the video at the book marked spot.

In view of the above, Applicants respectfully submit that the claim 1 is not anticipated or made obvious by the teachings of Gewickey. For example, Gewickey does not disclose or suggest a method that amongst other patentable elements, comprises (illustrative emphasis added) "wherein the system is operative to generate and to store a list of bookmarks, wherein each bookmark in the list of bookmarks includes a server content locator and a local content identifier to link a local content item to a related server content item; and wherein the rendering apparatus is operative to present the stored list of bookmarks to a user for selection of a bookmark and render a server content item indicated by the server content locator of a user-selected bookmark conditional on having access to a local content title associated with the local content identifier of the user-selected bookmark" as recited in claim 1, and as similarly claimed in independent claim 19.

To reiterate, as demonstrated above, Gewickey shows the use of "bookmarks" in the conventional sense where bookmarks are included in the actual video content to provide a forward and backward link from a point in the video media to web content. However, the

bookmarks in Gewickey are not generated and stored in a list of user-selectable bookmarks that are presented to a user, as contemplated by the claimed inventions, wherein each bookmark in the list of bookmarks presented to the user includes a server content locator and a local content identifier to link a local content item to a related server content item to enable controlled access to server content associated with local media content.

In addition, Applicants respectfully submit that the claim 18 is not anticipated or made obvious by the teachings of Gewickey. For example, Gewickey does not disclose or suggest a method that amongst other patentable elements, comprises (illustrative emphasis added) "generating and storing a new bookmark in a list of bookmarks to link the local content item to the related server content item, wherein the new bookmark includes the retrieved server content locator and corresponding local content identifier" as recited in claim 18. As described above Gewickey merely shows the use of conventional bookmarks in the sense where the bookmarks are included in the video content to provide a forward and backward link from a point in the video media to web content.

Based on the foregoing, the Applicants respectfully submit that independent claims 1, 18 and 19 are patentable over Gewickey and notice to this effect is earnestly solicited. Evans is cited for allegedly showing elements of a dependent claim and as such does nothing to cure the deficiencies in Gewickey. Claims 2-17 and 20 respectively depend from one of claims 1 and 19 and accordingly are allowable over Gewickey or Gewickey in combination with Evans, for at least this reason as well as for the separately patentable elements contained in each of the claims. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

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